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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,879	04/20/2000	John Carnahan	47004.000056	5010

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EXAMINER

CHENCINSKI, SIEGFRIED E

ART UNIT PAPER NUMBER

3628

DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/552,879	<b>Applicant(s)</b> CARNAHAN ET AL.	
	<b>Examiner</b> Siegfried E. Chencinski	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 26, 2004 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1 - 20 are rejected** under 35 U.S.C. 103(a) as being disclosed by Levine et al. (US Patent 6,233,566 B1).

**Re. Claims 1 & 11**, Levine discloses a system and method for multivariable comparison of financial information, comprising:

a client interface to a user operative to receive weightable search information, the weightable search information comprising user-selected quantitative search criteria and user-selected weighting criteria, the weighting criteria reflecting user-defined levels of importance for one or more of the quantitative search criteria; and a search interface, communicating with the client interface, the search interface operative to interrogate at least one network-enabled information source according to the weightable search information (Col. 5, lines 55-56; Col. 6, lines 34-37, 52-53; Col. 21, lines 24-33; weightable – Col. 22, lines 54-56; Col. 26, lines 5-9; certain criteria – Col. 8, lines 4-6; user selected quantitative criteria – Col. 14, ll. 54-58. The weighting

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criteria within the context of applicant's invention are more flexible than Levine's, but would have been obvious to an ordinary practitioner of the art at the time of applicant's invention.).

**Claims 2 & 12**, Levine discloses a system and method wherein the client interface comprises a communications link for transmitting the weightable search information to a transaction server and transmitting the search results to the user (Col. 28, lines 27-42).

**Claims 3 & 13**, Levine discloses a system and method wherein the client interface comprises a graphical user interface for displaying at least one of the weightable search information, the search results, and graphical coding objects associated with the search results (Col. 6, lines 52-53, Fig's 7-14).

**Claims 4 & 14**, Levine discloses a system and method wherein the client interface comprises a network-enabled connection to a client workstation (Col. 28, lines 27-42).

**Claims 5 & 15**, Levine discloses a system and method wherein the network-enabled connection comprises an Internet connection (Col. 6, lines 34-38, Fig's 2A & 2B).

**Claims 6 & 16**, Levine discloses a system and method wherein the weightable search information comprises multivariable financial information (Col. 22, lines 54-56; Col. 26, lines 8-9).

**Claims 7 & 17**, Levine discloses a system and method wherein the weightable search information comprises weighting information to be applied to the multivariable financial information to generate a composite results score (Col. 2, lines 38-45).

**Claims 8 & 18**, Levine discloses a system and method wherein the weightable search information is modifiable to be applied to the search results (Beginning a new search using modified criteria is an inherent capability of Levine).

**Claims 9 & 19**, Levine discloses a system and method wherein the search interface comprises a connection to a relational database (Col. 16, line 48; Col. 27, line 43).

**Claims 10 & 20**, Levine discloses a system and method wherein the client interface comprises at least one of keyboard input, voice input, touch pad input, voice output, pointing device input, speech input, biometric input, and graphical output at the client workstation (Client interface devices are inherent components of Levine's system and method).

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**3. Claims 21 - 34 are rejected** under 35 U.S.C. 103(a) as being disclosed by Levine et al. in view of Reese (US Patent 6,370,516 B1), O'Shaughnessy (US Patent 6,317,726 B1) and Hambrecht et al. (US Patent 6,629,082 B1).

**Re. Claims 21 & 28,** Levine discloses a system for multivariable comparison of financial information, comprising:

- a client interface to a user operative to receive weightable search information, the weightable search information comprising user-selected quantitative search criteria and user-selected weighting criteria, the weighting criteria reflecting user-defined levels of importance for one or more of the quantitative search criteria; and a search interface, communicating with the client interface, the search interface operative to interrogate at least one network-enabled information source according to the weightable search information to generate search results (See the rejection of claim 1 above);
- wherein the financial information comprises a plurality of investment funds, each having multiple quantitative investment fund variables associated therewith (It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention that financial information includes information about investment funds); and
- the search interface is operative to compare the quantitative investment fund variables with the user-selected quantitative search criteria and the user-selected weighting criteria to generate search results comprising investment funds.

Levine does not explicitly disclose the generation of search results that at least partially satisfy the user-selected quantitative search criteria and user-selected weighting criteria. However, Reese discloses search results that at least partially satisfy the user-selected quantitative search criteria and user-selected weighting criteria (Col. 23, ll. 35-37). Reese's disclosure is more sophisticated than Applicant's in this criterion, which all the more presents an ordinary practitioner options and suggestions for producing simpler search results which give comparative search results of investments which do

not fully meet the search criteria. Therefore, it would have been obvious to an ordinary practitioner of the art at the time of the invention to have combined the art of Levine with the art of Reese for the purpose of permitting the evaluation of degrees of fit to one's investment search criteria for the purpose of saving a user's time through a highly automated search tool capable of producing search results which partially satisfy a user's search and weighting criteria (Reese, Col. 1, ll. 59-65).

**Re. Claims 22 & 29**, Levine does not explicitly disclose financial information relating to mutual funds. However, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to understand that one or more investment funds can comprise one or more mutual funds, since mutual funds are financial investment funds.

**Re. Claims 23 & 30**, Levine discloses a system and method comprising a results interface operative to display the search results to the user (Col. 6, ll. 52-53; Fig's 7-14).

**Re. Claims 24 & 31**, Levine discloses a system and method wherein the results interface comprises a graphical user interface operative to display the one or more investment (Col. 6, ll. 52-53; Fig's 7-14). However, neither Levine nor Reese explicitly disclose the display of the one or more investment funds in a sortable list. However, O'Shaughnessy discloses the display the one or more investment funds in a sortable list (Col. 18, ll. 42-46, 50-62). Therefore, it would have been obvious to an ordinary practitioner of the art at the time of the invention to have combined the art of Levine and Reese with the art of O'Shaughnessy for the purpose of permitting the evaluation of search results in various sortable sequences for the purpose of reducing the complexity of the evaluation of investment information through a rule-based presentation available through automated sorting schemes to aid in investment decision making (O'Shaughnessy, Col. 1, ll. 45-51).

**Re. Claims 25, 26, 32 & 33**, Levine discloses a system and method wherein the one or more investment funds comprise one or more mutual funds. Neither Levine nor Reese explicitly disclose a results interface operative to receive requests for a prospectus or for an application for one or more of the one or more mutual funds. However, Hambrecht et al. disclose a hot link to an investment prospectus and to an investment application for a new issue of a financial security (Col. 9, ll. 7-17; Col. 10, l. 31 – Col.

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11, l. 10). It would have been obvious to an ordinary practitioner of the art at the time of the invention to have adapted the hot links tool for ordering information to a web site offering information on financial investments. It would therefor have been obvious to such ordinary practitioner to combine the art of Levine and Reese with the art of Hambrecht et al. for the purpose of offering a hot link attached to a financial information search web site's results interface for receiving requests for investment information such as a prospectus of a financial investment, including a mutual fund, and for ordering an application to invest in one or more financial securities, including mutual funds.

**Re. Claims 27&34**, Levine discloses a system and method wherein the search interface is operative to compare the quantitative investment fund variables with the user-selected quantitative search criteria and the user-selected weighting criteria to generate a first set of search results comprising investment funds that satisfy all of the user-selected quantitative search criteria (See the rejection of claim 1). Also, Reese discloses a system and method for producing a set of search results that do not satisfy all of the user defined quantitative search criteria, but satisfy at least a portion of the user-selected weighting criteria (See the rejection of claim 21, element (d)). It would have been obvious to an ordinary practitioner of the art at the time of the invention to have combined the art of Levine with the art of Reese for the purpose of saving a user's time through a highly automated search tool capable of producing search results which produce search results which can deliver exact matches for the user's search criteria as well as search results which only partially satisfy a user's search and weighting criteria in order to save a user search and evaluation time (Reese, Col. 1, ll. 59-65).

**4. Claims 35 - 40 are rejected** under 35 U.S.C. 103(a) as being disclosed by Levine et al. in view of Chang (US Patent 5,848,400), O'Shaughnessy and Hambrecht et al.

**Re. Claim 35**, Levine discloses a system for multivariable comparison of financial information, comprising:

- a client interface to a user operative to (Col. 28, ll. 27-42; Fig's 7-14):

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- receive a selection from a plurality of predetermined profiles, wherein each of the predetermined profiles comprises predetermined quantitative search information (Predetermined Profiles - Col. 13, ll. 60-63; Col. 15, ll. 54-55);
- create a custom profile by receiving weightable search information, the weightable search information comprising user-selected quantitative search criteria and user-selected weighting criteria, the weighting criteria reflecting user-defined levels of importance for one or more of the quantitative search criteria (Creating a custom profile - Col. 14, ll. 54-58; Col. 15, ll. 54-55);
- receive a user selection between the first client interface and the second client interface (Col. 28, ll. 27-42; Fig's 7-14);
- a search interface, communicating with the client interface, the search interface operative to interrogate at least one network-enabled information source according to at least one of the plurality of predetermined profiles and the custom profile to generate search results (Fig's 7-14); and
- a results interface operative to display the results to the user (Fig's 7-14, 18, 19).

Levine does not explicitly describe a first, second and third interface. However, Chang's disclosure makes use of a numbering scheme as part of describing the role of interfaces in a financial transaction system (Abstract, ll. 11-19). It would have been obvious to an ordinary practitioner of the art at the time of the invention to have combined the art of Levine with the art of Chang for the purpose of identifying a plurality of client interfaces in order to more quickly and easily complete an evaluation of investment options from a remote location through an automated computer network (Chang, Col. 1, ll. 49-54).

**Re. Claim 36**, Levine discloses a system wherein each of the predetermined profiles further comprises predetermined weighting criteria (Col. 22, ll. 54-66; Col. 26, ll. 5-9).

**Re. Claim 37**, Levine does not explicitly disclose financial information relating to mutual funds. However, it would have been obvious to an ordinary practitioner of the art at the



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time of Applicant's invention to understand that one or more investment funds can comprise one or more mutual funds, since mutual funds are financial investment funds.

**Re. Claim 38**, Levine discloses a system wherein the results interface comprises a graphical user interface operative to display one or more of the plurality of mutual funds (Col. 6, ll. 52-53; Fig's 7-14; mutual funds – see claim 37). However, neither Levine nor Chang explicitly disclose the display of the one or more mutual funds in a sortable list. However, O'Shaughnessy discloses the display of one or more investment funds in a sortable list (Col. 18, ll. 42-46, 50-62). Therefor, it would have been obvious to an ordinary practitioner of the art at the time of the invention to have combined the art of Levine and Chang with the art of O'Shaughnessy for the purpose of permitting the evaluation of search results in various sortable sequences for the purpose of reducing the complexity of the evaluation of mutual fund investment information through a rule-based presentation available through automated sorting schemes to aid in investment decision making (O'Shaughnessy, Col. 1, ll. 45-51).

**Re. Claims 39 & 40**, neither Levine nor Chang explicitly disclose a system wherein the results interface is operative to receive requests for a prospectus and/or an application for one or more of the plurality of mutual funds. However, Hambrecht et al. disclose a hot link to an investment prospectus and to an investment application for a new issue of a financial security (Col. 9, ll. 7-17; Col. 10, l. 31 – Col. 11, l. 10). It would have been obvious to an ordinary practitioner of the art at the time of the invention to have adapted the hot links tool for ordering information to a web site offering information on financial investments. It would therefor have been obvious to such ordinary practitioner to combine the art of Levine and Chang with the art of Hambrecht et al. for the purpose of offering a hot link attached to a financial information search web site's results interface for receiving requests for investment information such as a prospectus of a financial investment, including a mutual fund, and for ordering an application to invest in one or more financial securities, including mutual funds.

### ***Response to Arguments***

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5. Applicant's arguments filed July 26, 2004 have been fully considered but they are moot in view of the new basis of rejections.

**Conclusion**

6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is 703-305-6199. The Examiner can normally be reached Monday through Friday, 9am to 6pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Hyung S. Souh, can be reached on 703- 308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

*Commissioner of Patents and Trademarks Washington D.C. 20231*

*or faxed to:*

(703)872-9326      *[Before Final communications, labeled "Box BF"]*


(703)872-9327      *[After Final communications, labeled "Box AF"]*

(703) 872-9325      *[Customer Service]*

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

SEC

August 16, 2004

  
JEFFREY PWU  
PRIMARY EXAMINER